Remarks

In response to the outstanding requirement for restriction applicants hereby elect the claims of Group I, i.e., claims 1-8, 11, 31-38, and newly added claim 42, drawn to a fusion protein that comprises an antigen, a transmembrane region, and a cytoplasmic region of a chain of an MHC molecule, and a pharmaceutical composition thereof.

Regarding election of species, applicants elect the fusion protein which has the amino acid residue sequence of SEQ ID NO: 12. This particular fusion protein is an HLA Class I molecule in which the transmembrane and cytoplasmic regions are represented by SEQ ID NO: 4 present at amino acid positions 599-653 of SEQ ID NO: 12. The antigen sequence is the sequence of human cytomegalovirus phosphoprotein 65 (pp 65), SEQ ID NO: 10 present at amino acid positions 36-596 of SEQ ID NO: 12.

The foregoing elections are made with traverse.

Claims 1-7, 33, 34, 37 and 42 read on the elected species.

Reconsideration of the restriction requirement is requested.

In imposing the restriction requirement the Examiner has given Claim 1 an unduly broad interpretation beyond the teachings of the specification. As recently noted by the Court of Appeals for the Federal Circuit, the broadest-construction rubric coupled with the term "comprising" does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. In re Suitco Surface, Inc., 94 U.S.P.Q.2d 1640, 1644, citing Schriber Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940) ("The claims of a patent are always to be read or interpreted in light of its specification").

Furthermore, the restriction requirement is not in compliance with the M.P.E.P. It is well established that the Office Action must provide a rationale on the record to support a restriction requirement. More specifically, M.P.E.P. §808 states:

> The requirement to restrict has two aspects, (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s) and (B) why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting on restriction therebetween.... (emphasis in original).

In the present case, the Office Action has failed to show or provide adequate reasoning to support the restriction requirement. The Office Action merely concludes that each group represents a separate and distinct invention, without providing adequate evidence in support thereof. The Office Action merely concludes that the various groups are regarded as distinct and independent. Consequently, the restriction requirement is not in compliance with M.P.E.P. §808, and withdrawal thereof is respectfully requested.

It is also noted that the requirement for restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142 but is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. See, for example, Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); aff'd 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). Therefore, to promote the interest of both the public as well as the applicants, the restriction requirement should not be imposed without a specific analysis which supports the conclusions that two or more independent and distinct inventions are indeed claimed in one application.

In addition, the courts have recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The C.C.P.A. has observed:

> We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

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Kindly charge our Deposit Account No. 15-0508 in the amount of $26.00 for one additional dependent claim in excess of 20.

Respectfully submitted,

October 22, 2010

By _____
Talivaldis Cepuritis (Reg. No. 20,818)

OLSON & CEPURITIS, LTD.
20 North Wacker Drive
36th Floor
Chicago, Illinois 60606
(312) 580-1180

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT AND RESPONSE TO RESTRICTION REQUIREMENT is being transmitted by facsimile transmission to Fax No. 571-273-8300 on October 22, 2010.

_____
Talivaldis Cepuritis (Reg. No. 20,818)

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